



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,479	10/06/2000	Hidehiro Matsumoto	Q61026	8765

7590 05/12/2003

SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 Pennsylvania Avenue N W
Washington, DC 20037-3213

EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
----------	--------------

2174

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,479

Applicant(s)

NAKAYAMA ET AL.

Examiner

Truc T Chuong

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 10, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Dozier et al. (U.S. Patent No. 5,870,552).

As to claims 1 and 22, Dozier teaches a portable terminal system comprising:

a server (server, col. 5 line 45 and col. 6 line 44) storing text contents (source document, col. 6 lines 42-52) which are supposed to be displayed at a display section of a portable terminal (client computer, col. 6 lines 42-43), and Dozier shows help contents (suggested anchor items, col. 14 lines 24-42) which show a method of utilizing said text contents (col. 14 lines 29-53); and

a portable terminal including a text browser (figs. 8a-b and 10a-d) provided for use in perusing the text contents stored in said server (server, col. 5 line 45 and 6 line 44),

Art Unit: 2174

and provided for use in perusing the help contents also stored in said server (col. 3 lines 50-56).

As to claims 2 and 10, Dozier teaches a portable terminal includes a text browser (figs. 8a-b and 10a-d) provided for user in perusing text contents which are supposed to be displayed at a display section of the portable terminal (client computer, col. 3 lines 55-56 and col. 6 lines 42-43), and help browser provided for use in perusing help contents which show a method of utilizing said text contents (col. 14 lines 29-53).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-9, 11-21, and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier et al. (U.S. Patent No. 5,870,552) in view of Pepe et al. (U.S. Patent No. 5,742,905).

As to claims 8, 9, 16, and 17, Dozier teaches that portable terminal (see claim 1 above) but does not clearly show the portable terminal can be a cellular phone and a pager, and the PDA set to the effective state, said switch-key controlling means lights up light (or vibrates) emitting sections (or buttons) corresponding to the switch keys being set to the effective state. Pepe clearly teaches a cellular phone, PDA with all functions of a regular PDA (col. 5 lines 41-67) so the PDA can be set to the effective state, said switch-key controlling means lights up light (or vibrates) emitting sections (or buttons) corresponding to the switch keys being set to the effective

Art Unit: 2174

state. It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to have Pepe's PDA with all features in Dozier's template editing system to provide services to users to communicate from anywhere to anywhere at any time (col. 1 lines 36-39).

As to claims 25, 26, 28 and 29, they are similar in scope to claims 8 and 9. Note the rejections of claims 8 and 9 above.

As to claims 3, 11, and 24, Dozier teaches a portable terminal to display text contents and help contents on a browser (see claim 1 above); however, Dozier does not further teach that the portable terminal includes a judging means for judging whether a message inputted from outside belongs to a text message or a help message, and activates either said text browser or said help browser in accordance with a result of judgment by the judging mean. Pepe clearly teaches the judging means for judging whether a message belong to text contents or help contents (using segment IDs in message delivery and notifications, col. 14 lines 53-67 and col. 15 lines 1-15). It would have been obvious at the time of the invention that a person with ordinary skill in the art would add this highly desirable judgment feature of Pepe's communication system in Dozier so that the information can be divided independently and uniquely (col. 14 lines 54-56).

As to claims 4 and 12, Dozier provides help browser outputs said help contents as text, voice, static images, moving images (col. 1 lines 40-65 and figs. 4, 8a-b).

As to claim 18, it is a method claim that corresponds to the product of claims 10-11. Note the rejections of claims 10-11 above.

As to claim 19, it is a method claim that corresponds to the product of claim 12. Note the rejection of claim 12 above.

Art Unit: 2174

As to claim 20, it is a program product claim that corresponds to the product and method claims 10, 11, and 18. Note the rejections of claims 10, 11, and 18 above.

As to claim 21, it is a program product claim that corresponds to the product and method claims 12 and 19 above. Note the rejections of claims 12 and 19 above.

As to claims 5, 6, 7, 13, 14, 15, and 23 Dozier provides a plurality of switch keys for use operations for using said text contents, and switch-key controlling means for setting each of said plurality of switch keys to either an effective state or an ineffective state depending on the contents of said help contents (using icons, col. 4 lines 11-26).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hickey et al. (U.S. Patent No. 5,889,516) teach portable terminal, wireless communication, and interact with network (cols. 2-5, 8 and figs. 1, 3, 10-31).

Iwata et al. (U.S. Patent No. 5,646,649) teach portable information terminal and input buttons (cols. 2-4 and 5-7, figs. 2, 4, and 7).

Koenck et al. (U.S. Patent No. 5,202,817) teach portable, hand-held data collection terminal unit and function keys (cols. 3-10, figs. 4-10).

Macor (U.S. Patent No. 5,841,849) teaches personal telecommunication device, display browser, and function keys (cols. 2-6, figs. 1-10).

Mendez et al. (U.S. Patent No. 5,961,590) teach PDA, laptop, and web browser (cols. 4-6).

Art Unit: 2174

Nazanin et al. (U.S. Patent No. 5,625,683) teach cellular phone (fig. 1).

Suzuki et al. (U.S. Patent No. 5,956,655) teach portable communication device, input keys, and a plurality of display (cols. 4-12, figs. 1, 2, and 28).

Taylor et al. (U.S. Patent No. 5,754,306) teach remote computer, text screen, and browser (cols. 2-10, 13-19 and figs. 4-23).

Tichy (U.S. Patent No. 5,517,574) teaches cellular phone housing and keys (fig. 4).

Arora et al. (U.S. Patent No. 5,845,299) teach HTML, help, text, template, browser, and display tools (cols. 2-20 and figs. 3-18).

Hanson et al. (U.S. Patent No. 5,956,736) teach HTML editor, template, and web browser (cols. 4-15 and figs. 3-9).

Jones et al. (U.S. Patent No. 5,644,334) teach editing, template, text, guideline, and different displays (cols. 3-12 and figs. 4-7).

McDonald et al. (U.S. Patent No. 5,966,532) teach wizard, control, template, utilizing, and displays (cols. 3-25 and figs. 8-32).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 703-305-5753. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on 703-308-0640. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2174

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Truc T. Chuong
May 5, 2003

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100